REMARKS/ARGUMENTS

Claim 1 was previously cancelled. Claims 2-13 are pending. The Examiner rejected claim 2 under 35 U.S.C. 103(a) as being obvious over Rainey (U.S. Patent No. 5,634,856) in view of Turner (U.S. Patent No. 5,575,473). Rainey indicates that striking member 30 may be a bearing ball element. The Examiner then concluded that since Rainey uses the words "may be" that any other element may be also used and suggests that a hollow sliding inner tube could be used. Applicant respectfully points out that the entire statement made by Rainey in the patent with respect to his striking member is the following at Column 3, lines 23-26: "Striking member 30, which may be a bearing ball element or a weight, preferably made of hardened steel, is loosely confined within tubular body central portion 23 and plug 32 is fitted within handle end portion 25." Thus, what Rainey is teaching is using a bearing ball element OR A WEIGHT (emphasis added). Nowhere does Rainey ever teach or suggest the use of a hollow anything, let alone a hollow, light weight inner tube, but rather a solid weight.

Furthermore, Rainey also requires that the element be "loosely confined within tubular body central portion..." The reason for this limitation is that the standard laws of science apply to the design of Rainey's apparatus. If a solid bearing ball is used, as proposed by Rainey, then it must be smaller than the inner diameter of the tube. If instead a solid bearing ball were used by Rainey that approached the size of the inner diameter of Rainey's tube there would be no place for the displaced air to move to allow such a solid bearing ball to move the length of the tube. Thus, Rainey requires that the bearing ball be smaller than the size of the inner diameter of the tube to permit it to have room to displace the air. Because the bearing ball must be smaller than the inner diameter of the tube, in order for the bearing ball to make any sound when it hits the end of the tube, it must have sufficient weight. Thus, what Rainey teaches and claims is a training apparatus that uses a bearing ball or weight that is smaller than the inner diameter of the tube so that it may travel the length of the tube and be of sufficient weight so that it will make a sound upon impact at the end of the tube.

In citing Rainey as the basis for a 103 obviousness rejection, Applicant respectfully argues that the Examiner is citing prior art that teaches away from using a hollow, light weight, sliding inner tube with an outside diameter slightly less than the inner diameter of an outer tube in which Applicant's inner tube slides. Rainey teaches using a solid bearing ball or a weight.

Someone wanting to utilize the teachings of Rainey would thus be inclined to use a solid element with enough mass to cause a sound to be made. It would thus clearly not be obvious to use a hollow, light weight sliding inner tube on the basis of Rainey. Teaching away is the antithesis of the art suggesting that the person of ordinary skill go in the claimed direction. *In re Fine*, 873 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Teaching away from the art is a per se demonstration of lack of prima facie obviousness.

The Examiner must show as a basis for a 103 rejection some motivation or suggestion to try a hollow, light weight, sliding inner tube with an outer diameter slightly less than the size of the inner diameter of the outer tube. Nowhere in Rainey is there anything to suggest using a very lightweight hollow sliding inner tube. The Examiner has not pointed out the required motivation or suggestion, and thus has not made out a prima facie case of obviousness. The Examiner, furthermore, must show that there is a reasonable expectation of success but instead has improperly argued that it would be "obvious to try" a modification. See *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

In citing Rainey, the Examiner does not cite a prior art reference that teaches the problem or its source. Rainey places no weight limitations on the bearing ball or weight. Rainey's ball bearing or weight may contribute to centrifugal motion problems where the ball bearing or weight adds extra weight to the end of the apparatus and thereby distorts a real world batting swing that is supposed to be taught by the apparatus. There are at least two inherent problems in Rainey's design that are not addressed by Rainey. First, there is the problem that the mass must allow air to be displaced as the object moves from one end to the other end. Next, is the problem of a weighted solid mass contributing to a distorted swing caused by centrifugal motion. In one embodiment of Applicant's invention (as described in the specification), the sliding hollow inner tube weighs a miniscule 2.8 grams. This is the weight of five (5) standard aspirin tablets whose standard weight is 500 mg. Clearly, the weight of Applicant's hollow inner tube is negligible in comparison to Rainey's bearing ball/weight. With such a small weight as used by Applicant, no centrifugal motion problems are generated. By being hollow, as in Applicant's device, an air passage forms, which allows air to be displaced as it moves within the length of the tube. Nonetheless, the construction of the hollow sliding inner tube permits a distinct audible sound that the user can hear. If recognition of the source of the problem is not taught or suggested by

the prior art, then a rejection for prima facie obviousness is defective even if the solution claimed would have been otherwise obvious, see *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923). For all the foregoing reasons, Applicant respectfully submits that Examiner has not made a prima facie case of obviousness in citing Rainey in view of Turner, and thus claim 2, as previously amended, should be allowed. As the Examiner has stated, Turner merely teaches the use of an end cap.

The Examiner has rejected dependent claims 3-7, independent claim 8, and independent claims 9-13 as being unpatentable over the references as applied to claim 2 above, and further in view of Piazza. For the foregoing reasons, the arguments used above for claim 2 also apply to claims 3, 5-9, and 11-13. Furthermore, as previously argued, the invention taught and claimed by Piazza deals with "A hollow bat for baseball practice having an internal longitudinal rod and moveable weight which will increase the inertia of the bat during swinging" (as stated in the abstract of Piazza). Applicant indicated in the phone conference with the Examiner on July 29, 2003, and also in Applicant's previous response, that Piazza (i) does not have a uniform inner and outer diameter but is tapered; (ii) does not have a bat portion that inserts into a handle but instead has a removable handle that can be screwed on and off to permit exchanging weights; (iii) does not permit the weight to slide for the entire length of the bat because of the way the handle is formed to prevent passage of the weight; and (iv) teaches an inertia top-weighted bat with a relatively heavy sliding weight that moves on a guide rod by centrifugal motion towards the top portion of the bat. Neither Rainey nor Piazza addresses the problem of inertia and momentum when they teach and claim an apparatus that uses ball bearings or a weight. If recognition of the source of the problem is not taught or suggested by the prior art, then a rejection for prima facie obviousness is defective even if the solution claimed would have been otherwise obvious. See *Eibel Process Co. v. Minnesota & Ontario Paper Co.*, 261 U.S. 45 (1923).

Moreover, the Examiner states that "it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide plastic parts as taught by Piazza in the Rainey device..." However, the Examiner has neither provided motivation for doing so, nor any teaching in Rainey or Piazza that address the problem caused by inertia, as neither of these references take into account the momentum problems caused by the weighted element. For all

the foregoing reasons, Applicant respectfully submits that Examiner has not made a prima facie case of obviousness in citing Rainey in view of Piazza, and thus claims 3, 5-9, and 11-13 as previously amended should be allowed.2

The Examiner has rejected claims 4 and 10 under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 2 above, and further in view of Tyner (U.S. Patent No. 6,254,498). For the foregoing reasons, the arguments used above for claim 2 also apply to claims 4 and 10. Since independent claim 2, from which claim 4 depends, and independent claim 8, from which dependent claim 10 depends, have both been demonstrated to be allowable, it is respectfully submitted that claims 4 and 10 are also deemed to be allowable.

Conclusion

If the Examiner believes a conference with Applicant's attorney would expedite or conclude prosecution of this application, then the Examiner is cordially invited to contact Applicant's attorney by telephone at the below-listed number.

Applicant respectfully submits that the claims are clearly allowable for the reasons stated herein, and therefore request such allowance.

Respectfully submitted,

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